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EXAMINER

GEDRICH, SARAH R

ART UNIT PAPER NUMBER

3625

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,684

Applicant(s)

NABB ET AL.

Examiner

Sarah R. Gedrich

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-20 are pending.

Response to Arguments

The Examiner notes that box 12 of the Office Action Summary was checked in error and concedes that no claim for foreign priority was made. The Examiner further notes that the IDS filed 7 December 2001 was considered, although it fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it lacks copies of each of the cited non-patent literature. See MPEP § 609 ¶ C(1).

Applicant's arguments, see Page 4, lines 19-21, page 5, lines 4-6, and page 6, lines 15-18, filed 20 January 2005, with respect to the rejection(s) of claim(s) 1-20 under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Huberman US Patent No. 5,826,244 and Kinkos.com as cited on February 29, 2000 and Blumberg et al. Patent Application Publication US 2003/0140315.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by
Huberman US Patent No. 5,826,244.**

Huberman discloses a method and system for providing a document service over a computer network using an automated brokered auction. Huberman further discloses:

1. Referring to claim 18. A method of submitting a copy reproduction order request to a copy reproduction service provider, the method comprising the steps of:

- Accessing, by a user, a copy reproduction application from a computer network: the company's purchasing officer logs onto, for example, the Internet (assumed here to support data encryption and other protocols to ensure the security of financial transactions) and contacts a document services broker (Huberman: Column 4, lines 48-53). The broker has a World Wide Web site or other suitable site on the Internet, and can accept the purchasing officer's request electronically at that site (Huberman: Column 4, lines 54-57).
- Selecting, by a user, a copy reproduction service to be provided by a copy reproduction service provider using the copy reproduction application: The purchasing officer places the printing and mailing request with the broker (Huberman: Column 4, lines 59-66).
- Completing, by a user, a copy reproduction order request for the selected copy reproduction service using the copy reproduction application: The purchasing officer places the printing and mailing request with the broker, providing particulars such as the number of copies to be printed, the size and paper quality of the report, the geographic distribution of the stockholders on the mailing list,

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the timetable for completion of the job, and any other particulars that will be needed for suppliers to estimate their costs for completing the job (Huberman: Column 4, lines 59-66).

- Storing the completed copy reproduction order request in a database, the completed copy reproduction order request including at least one file having material to be copied by the copy reproduction service provider: the broker has a World Wide Web site or other suitable site on the Internet, and can accept the purchasing officer's request electronically at that site (Huberman: Column 4, lines 54-57). Network 100 has hardware nodes 104 interconnected by a communications matrix 110 (Huberman: Column 4, lines 62-63). Nodes 104 can be computers, such as personal computers, workstations, servers, or mainframe computers (Huberman: Column 6, lines 5-6). The Examiner notes that the computers, servers, etc. typically contain a memory for storage and that the website's ability to "accept" purchaser requests would include storing them on the website's server.
- Accessing, by the copy reproduction service provider, a plurality of copy reproduction order requests from the database using a service provider application: The broker can, for example, broadcast or multicast the job requirements to numerous suppliers who can then bid on it in a competitive auction (Huberman: Column 4, lines 2-5). The broker process 230 can be configured to conduct multiple auctions for multiple jobs contemporaneously

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(Huberman: Column 18, lines 38-40). The Examiner notes that multiple jobs are multicast on the brokers website which is accessed by the suppliers to bid on.

- Downloading from the database, by the copy reproduction service provider, the at least one file having material to be copied for a copy reproduction order request selected by the copy reproduction service provider for making copies of the material to be copied: The substance of the job (e.g., the contents of the report and the names in the stockholder mailing list) can be provided electronically to the supplier by the customer, either directly or through the broker, along with accounting information such as the customer's billing address or credit card or electronic funds transfer information and the payment terms (Huberman: Column 5, lines 17-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman in view of Blumberg et al Patent Application Publication US2003/0140315 (hereinafter referred to as "Blumberg").

Huberman further discloses:

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2. Referring to claim 1. A system for submitting and monitoring copy reproduction order requests, the system comprising:

- A database to store information on copy reproduction requests, wherein the stored information comprises order information on copy reproduction requests and status information on copy reproduction requests: the broker has a World Wide Web site or other suitable site on the Internet, and can accept the purchasing officer's request electronically at that site (Huberman: Column 4, lines 54-57). Network 100 has hardware nodes 104 interconnected by a communications matrix 110 (Huberman: Column 4, lines 62-63). Nodes 104 can be computers, such as personal computers, workstations, servers, or mainframe computers (Huberman: Column 6, lines 5-6). The Examiner notes that the computers, servers, etc. typically contain a memory for storage and that the websites ability to "accept" purchaser requests would include storing them on the website's server.
- A first client computer communicating with the database, wherein the first client computer being accessible by a user: Network 100 has hardware nodes 104 interconnected by a communications matrix 110 (Huberman: Column 4, lines 62-63). Nodes 104 can be computers, such as personal computers, workstations, servers, or mainframe computers (Huberman: Column 6, lines 5-6). The real-world customer and suppliers can also be machines or other automated resources affiliated with consuming and producing document services (Huberman: Column 6, lines 50-52).

- A second client computer communicating with the database to access the stored information on copy reproduction requests in the database, wherein the second client computer being accessible by a copy reproduction service provider:

Network 100 has hardware nodes 104 interconnected by a communications matrix 110 (Huberman: Column 4, lines 62-63). Nodes 104 can be computers, such as personal computers, workstations, servers, or mainframe computers (Huberman: Column 6, lines 5-6). The real-world customer and suppliers can also be machines or other automated resources affiliated with consuming and producing document services (Huberman: Column 6, lines 50-52).

An application for submitting and monitoring copy reproduction requests accessible on the first client computer by a user, the application comprising:

- Means for entering order information on a copy reproduction request by a user:

The purchasing officer places the printing and mailing request with the broker, providing particulars such as the number of copies to be printed, the size and paper quality of the report, the geographic distribution of the stockholders on the mailing list, the timetable for completion of the job, and any other particulars that will be needed for suppliers to estimate their costs for completing the job (Huberman: Column 4, lines 59-66).

- Means for storing the entered order information on a copy reproduction request in the database: the broker has a World Wide Web site or other suitable site on the Internet, and can accept the purchasing officer's request electronically at that site (Huberman: Column 4, lines 54-57). Network 100 has hardware nodes 104

interconnected by a communications matrix 110 (Huberman: Column 4, lines 62-63). Nodes 104 can be computers, such as personal computers, workstations, servers, or mainframe computers (Huberman: Column 6, lines 5-6). The Examiner notes that the computers, servers, etc. typically contain a memory for storage and that the website's ability to "accept" purchaser requests would include storing them on the website's server.

Huberman fails to disclose means for retrieving status information from the database on a copy reproduction request submitted by a user. Blumberg discloses a Print On Demand Virtual Builder. Blumberg further discloses:

- Means for retrieving status information from the database on a copy reproduction request submitted by a user: The user can subsequently determine the status of his job by querying the order management software using the tracking identification number assigned to the job (Blumberg: paragraph 0116).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Huberman to include means for retrieving status information from the database on a copy reproduction request submitted by a user as taught by Blumberg in order to monitor the job's progress as it proceeds through the workflow (Blumberg: paragraph 0116).

3. Referring to claim 2. Huberman further discloses:

- The stored information further comprises at least one file having material to be copied by the copy reproduction service provider: The substance of the job (e.g., the contents of the report and the names in the stockholder mailing list) can be

provided electronically to the supplier by the customer, either directly or through the broker, along with accounting information such as the customer's billing address or credit card or electronic funds transfer information and the payment terms (Huberman: Column 5, lines 17-23). The Examiner notes that "particulars that will be needed for suppliers to estimate their costs for completing the job" are included in the request. This suggests that the file to be printed or copied could be included. The substance of the job being " provided electronically" suggests that the file is uploaded to the broker.

- The application further comprises means for uploading the at least one file having material to be copied to the database: The substance of the job (e.g., the contents of the report and the names in the stockholder mailing list) can be provided electronically to the supplier by the customer, either directly or through the broker, along with accounting information such as the customer's billing address or credit card or electronic funds transfer information and the payment terms (Huberman: Column 5, lines 17-23). The Examiner takes the position that the substance of the job being " provided electronically" suggests that the file is uploaded to the broker.
4. Referring to claim 3. Claim 3 is rejected on the same rationale as set forth above in claim 2. The Examiner notes that the request is also a mailing request and that the mailing list is "provided electronically" to the supplier through the broker.
5. Referring to claim 4. Huberman further discloses:

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An additional application for processing copy reproduction requests, wherein the additional application is accessible by a copy reproduction service provider on the second client computer, the additional application comprising:

- Means for reviewing order information from the database on a copy reproduction request by a user: The broker can, for example, broadcast or multicast the job requirements to numerous suppliers who can then bid on it in a competitive auction (Huberman: Column 4, lines 2-5). The broker process 230 can be configured to conduct multiple auctions for multiple jobs contemporaneously (Huberman: Column 18, lines 38-40). The Examiner notes that multiple jobs are multicast on the brokers website which is accessed by the suppliers to bid on.
- Means for downloading the at least one file having material to be copied from the database to the second client computer for a copy reproduction request by a user: The substance of the job (e.g., the contents of the report and the names in the stockholder mailing list) can be provided electronically to the supplier by the customer, either directly or through the broker, along with accounting information such as the customer's billing address or credit card or electronic funds transfer information and the payment terms (Huberman: Column 5, lines 17-23). The Examiner notes that the information "provided electronically" to the supplier through the broker would be downloaded.

Huberman fails to disclose means for updating the status information in the database for a copy reproduction request by a user. Blumberg further discloses:

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- Means for updating the status information in the database for a copy reproduction request by a user: The print service provider has an interface that allows the following features: ability to enter the status of a job (Blumberg: paragraphs 34-38).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Huberman to include means for updating the status information in the database for a copy reproduction request by a user as taught by Blumberg in order to allow the staff of the production center to update the job status (Blumberg: paragraph 039).

6. Referring to claim 5. Huberman further discloses:

- A server computer connected to the first client computer, the server computer comprising a storage device to store the application for submitting and monitoring copy reproduction requests; and an additional server computer connected to the second client computer the additional server computer comprising a storage device to store the additional application for processing copy reproduction requests: Network 100 has hardware nodes 104 interconnected by a communications matrix 110 (Huberman: Column 4, lines 62-63). Nodes 104 can be computers, such as personal computers, workstations, servers, or mainframe computers (Huberman: Column 6, lines 5-6). A local-area network, wide-area network, or collection of networks serving a particular customer, supplier, or broker can itself be treated as a node 104 of network 100 (Huberman: Column 6,

lines 15-20). The Examiner notes that the nodes represent clients, suppliers, or brokers and each can be a server.

7. Referring to claim 6. Huberman further discloses:

- Means for a copy reproduction service provider to provide authentication information to access the additional application for processing copy reproduction requests stored on the additional server computer: It will be appreciated that communications matrix 110 can be almost any digital communications infrastructure that provides adequate bandwidth and information security appropriate to the particular circumstances in which the invention is to be used (Huberman: Column 6, lines 30-35). The geographic locations of the suppliers are unimportant so long as their Internet addresses are known (Huberman: Column 5, lines 5-6). The Examiner notes that reasonable security is expected and that the Internet addresses of the supplier would have to be known. This suggests that the suppliers would be required to authenticate themselves through their Internet address.

8. Referring to claim 7. Huberman further discloses:

- The additional application for processing copy reproduction requests is accessed from the additional server computer on an Extranet and the database is accessed from an Intranet: A local-area network, wide-area network, or collection of networks serving a particular customer, supplier, or broker can itself be treated as a node 104 of network 100 (Huberman: Column 6, lines 15-20).

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9. Referring to claim 8. Huberman fails to disclose the stored information on copy reproduction requests in the database is stored as binary large objects. Blumberg further discloses:

- The stored information on copy reproduction requests in the database is stored as binary large objects: The documents used in the printing systems of the present invention are preferably documents stored in the Portable Document Format (PDF) of Adobe Systems, Inc. of San Jose, Calif. (Blumberg: paragraph 0109). The Examiner takes the position that PDF files are BLOBs.

IT would have been obvious to one of ordinary skill in the art at the time of the invention modify Huberman to include the stored information on copy reproduction requests in the database is stored as binary large objects as taught by Blumberg in order to render pages of a document as they appear within the finished document (Blumberg: paragraph 0109).

10. Referring to claim 9. Huberman further discloses:

- Means for changing, by a user, the status information on a copy reproduction request in the database: the customer can (and typically will) be given an opportunity to indicate to the broker whether an acceptable result has been reached, and if not, to decline or cancel the job altogether (Huberman: Column 4, lines 1-5).

11. Referring to claim 10. Huberman fails to disclose means for editing, by a user, the stored information on copy reproduction requests in the database and means for

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filtering, by a user, the stored information on copy reproduction requests in the database. Blumberg further discloses:

- Means for editing, by a user, the stored information on copy reproduction requests in the database: Creation and viewer software, referred to as "Virtual Builder," is used to create and interactively view a finished document, with user selected finishing options applied. As a user changes his selection of finishing options, Virtual Builder changes the display appropriately (Blumberg: paragraph 0059).
- Means for filtering, by a user, the stored information on copy reproduction requests in the database: Document management software is used to manage access to an archive of electronic documents. Such software organizes the documents into files and folders, provides access control to restrict access to designated documents by unauthenticated users, and provides search capability to retrieve documents with particular features (Blumberg: paragraph 0135).

It would have been obvious to one of ordinary skill in the art at the time of the invention. to modify Huberman to include means for editing, by a user, the stored information on copy reproduction requests in the database and means for filtering, by a user, the stored information on copy reproduction requests in the database as taught by Blumberg in order to allow the user to change the options s/he has selected (Blumberg: paragraph 0059), and to retrieve documents with particular features (Blumberg: paragraph 0135).

12. Referring to claim 20. Huberman fails to disclose storing the completed copy reproduction order request in a file directory and transferring the completed copy reproduction order request from the file directory to the database. Blumberg further discloses:

- Storing the completed copy reproduction order request in a file directory:
Documents produced by document authoring tool 240 are preferably uploaded to on-demand print server 210, which stores the documents using an electronic document management system 250 (Blumberg: paragraph 0143).
- Transferring the completed copy reproduction order request from the file directory to the database: The document and the job description file have been "transferred" from the Virtual builder server to the on-demand print server to the "electronic document management system" (Blumberg: paragraphs 0143-0144).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Huberman to include storing the completed copy reproduction order request in a file directory and transferring the completed copy reproduction order request from the file directory to the database as taught by Blumberg in order to provide a user with the ability to re-order printing of the document (Blumberg: paragraph 0142), and to allow the document to be viewed and then stored (Blumberg: paragraphs 0142-0144).

13. Referring to claims 12-17. Claims 12-17, written as a computer program product, is rejected on the same rationale as set forth above in claims 1-10, 18 and 20.

Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman in view of Blumberg in further view of the collection titled Kinkos.com which includes Kinkos.com as cited on 29 February 2000 (hereinafter referred to as "Kinkos.com") and Kinkos.com cited on 24 February 2004, previously submitted, (hereinafter referred to as "Kinkos.com Original").

The combination of Huberman and Blumberg disclose the invention described in the 35 U.S.C. 102(b) and 35 U.S.C. 103(a) rejection above.

14. Referring to claim 11. The combination fails to disclose entering order information on a copy reproduction request by a user further comprises a copy reproduction order form, a wide format order form, and a CD-ROM reproduction order form. Kinkos.com teaches online ordering of prints and copies. Kinkos.com further teaches:

- Entering order information on a copy reproduction request by a user further comprises a copy reproduction order form, a wide format order form, and a CD-ROM reproduction order form: The copy reproduction request on Kinkos.com uses an online order form (Kinkos.com: pages 1-7). Kinkos.com further discloses its ability to create wide format copies (Kinkos.com: pages 8-9), and copies of compact discs (Kinkos.com: pages 10 and 14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Huberman to include copy reproduction requests as a copy reproduction order form, wide format order form, and CD-ROM reproduction order form as taught by Kinkos.com in order to provide uniform ordering of all the services provided.

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15. Referring to claim 19. The combination further discloses:

- Uploading the at least one file having material to be copied by the copy reproduction service provider to the database: The substance of the job (e.g., the contents of the report and the names in the stockholder mailing list) can be provided electronically to the supplier by the customer, either directly or through the broker, along with accounting information such as the customer's billing address or credit card or electronic funds transfer information and the payment terms (Huberman: Column 5, lines 17-23).

The combination fails to disclose automatically entering into the copy reproduction order request, by the copy reproduction application, personal information of a user.

Kinkos.com further discloses:

- Automatically entering into the copy reproduction order request, by the copy reproduction application, personal information of a user: Kinkos.com shows that a person can store personal information that will be remembered and inserted upon return to the website (Kinkos.com Original: page 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include automatically entering into the copy reproduction order request, by the copy reproduction application, personal information of a user as taught by Kinkos.com Original in order to aid frequent users to quickly process orders.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

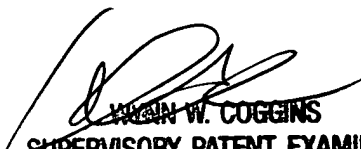
- Lacheze et al. Information Broker for Printing System. US Patent No. 5,956,698

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah R. Gedrich whose telephone number is (703) 306-5449. The examiner can normally be reached on M-F 7:30am - 5:00pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SRG


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